

REMARKS

In the Office Action dated May 21, 2004, claims 1-28 were presented for examination. The Examiner objected to claims 3, 9, 12, 18, 21, 25, and 26. Claims 1-28 were rejected under 35 U.S.C. §103(a).

Applicants wish to thank the Examiner for the careful and thorough review and action on the merits in this application. The following remarks are provided in support of the pending claims and responsive to the Office Action of May 21, 2004 for the pending application.

I. Objection to Claims 3, 9, 12, 18, 21, 25, and 26

In the Office Action of May 21, 2004, the Examiner assigned to the application objected to claims 3, 9, 12, 18, 21, 25, and 25 for containing informalities. Applicants have amended claims 3, 9, 21, 25, and 26 to correct the informalities.

II. Rejection of claims 1-28 under 35 U.S.C. §103(a)

Claims 1-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Elnozahy et al.* (U.S. Patent No. 6,701,421) *in view of* *Sayles* (U.S. Patent No. 6,549,963).

The *Elnozahy et al.* patent relates to a method and system for allocating memory in a data processing system. A configuration table is generated in response to a boot event to indicate the system's hardware resources. If one were to consider the configuration table of *Elnozahy et al.* equivalent to the first descriptor of Applicant's, *Elnozahy et al.* still does not show firmware producing a second descriptor, or an equivalent thereof, in addition to the configuration table. The *Sayles* patent relates to a method and system for configuring devices on a communication channel. At boot, a BIOS routine may change settings in devices coupled to a bus to indicate which transfer modes are supported and which are not. See Col. 3, lines 15-17. If one were to consider the BIOS routine of *Sayles* equivalent to the second descriptor of Applicants, *Sayles* still does not show firmware producing a first descriptor, or an equivalent thereof, in addition to the second descriptor.

As the CAFC has made clear, the prior art must teach the desirability of the modification. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is axiomatic that the subject matter of the claims may not be considered obvious as a result of a hypothetical combination of references unless something in the references suggests that an advantage may be derived from combining their teachings. In this respect, the CAFC appears to speak directly to the issue of the need to determine the scope and contents of the prior art. The prior art of *Elnozahy et al.* and *Sayles* do not suggest combining the production by the firmware of both first and second descriptors, as claimed by Applicants. Accordingly, the determination as to what may be within the scope and contents of the prior art serves to establish the parameters of what art may even be considered in determining the obviousness of an invention.


"Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d 1430 (Fed. Cir. 1990)). In fact, both *Elnozahy et al.* and *Sayles* teach away from the modification of the descriptors produced by the firmware suggested by the Examiner. *Elnozahy et al.* does not suggest modifying the firmware to accommodate producing a second descriptor in addition to the first descriptor. To read *Elnozahy et al.* as providing firmware to accommodate producing a second descriptor in addition to the first descriptor as taught by Applicants would require a modification to the invention of *Elnozahy et al.* not envisioned. Furthermore, there is no suggestion found in *Sayles* for a modification to the firmware to accommodate producing a first descriptor in addition to the second descriptor. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants disclosure." MPEP §2143 (citing *In re Vaack*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). The only suggestion for a system that utilizes the firmware to produce both the first and second descriptors is derived from Applicant's invention. The descriptors produced by the firmware of Applicants mitigates access time to resources among a plurality of nodes. Absent Applicant's

invention, there is no suggestion or motivation within the combination of *Elnozahy et al.* and *Sayles* for such a modification. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has attempted to undertake. The combination of the prior art references is improper as the Examiner's combination is precipitated by utilizing Applicant's claimed invention as the template to make the modifications suggested by the Examiner since such modifications to the prior art are not taught or suggested therein. Accordingly, Applicants respectfully requests the Examiner remove the rejection of claims 1-28 and provide allowance of this application.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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